IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	:	Lisa A. Fillebrown, et al.,
Serial No.	:	09/775,042
Filed	:	February 1, 2001
For	:	METHOD FOR SUPPORTING A PERSONAL WIRELESS NETWORK
Group No.	:	2451
Examiner	:	Maung, Zarni
Confirmation No.	:	8351

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

This Brief is responsive to the Notice of Panel Decision mailed October 21, 2008. Appellants herewith respectfully submit that the Examiner's decision of April 04, 2008, finally rejecting Claims 11-22, 30, 32, 33, 36, 37, 40, 45 and 46 in the present application, should be reversed, in view of the following arguments and authorities. This Brief is submitted subsequent to the Notice of Appeal filed August 04, 2008. The fee for a Brief on Appeal is enclosed.

01/27/2009 SLUANG1 00000018 09775042

01 FC:2402   270.00 OP

01/27/2009 SLUANG1 00000018 09775042
02 FC:2252   245.00 OP

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Real Party in Interest

The real party in interest, and assignee of this case, is ENFORA, INC., a Delaware Corporation, whose principal office and place of business is at 661 East 18th Street, Plano, Texas 75074.

Related Appeals or Interferences

Appellants have the following related-application pending appeals:

- None.

Appellants have filed Notices of Appeal in the following related applications:

- None.

The above-identified patent application has no related interferences.

Status of Claims

Claims 1-22, 30, 32, 33, 36, 37, 40, 45 and 46 from the application are pending, stand firmly rejected, and are on appeal here. A complete and current listing of Claims 1-22, 30, 32, 33, 36, 37, 40, 45 and 46 are attached here in the **CLAIMS APPENDIX**.

Status of Amendments after Final

Appellants filed a Pre-Appeal Brief Request for Review on August 04, 2008, with its Reason in Support of Pre-Appeal Brief Request for Review which rejected Claims 1-22, 30, 32, 33, 36, 37, 40, 45 and 46, in response to the Final Office Action, mailed April 04, 2008. An amendment filed February 04, 2008 was the last Response amending the claims and was the last Response entered.

Summary of Claimed Subject Matter

The following summary refers to disclosed embodiments and their advantages, but does not delimit any of the claimed inventions.

In General

The present application is directed, in general, to computer networks and wireless devices and, more specifically, to wireless computer networks.[1]

Support for Independent Claims

Note that, per 37 CFR 41.37, only each of the independent claims are discussed in this section, as well as any claims including means-plus-function language that is argued separately below. In the arguments below, however, various dependent claims may also be discussed and distinguished from the prior art. The discussion of the claims is for illustrative purposes, and is not intended to affect the scope of the claims.

The current invention, as set forth currently in Independent Claim 1, relates to a method of processing a packet in a wireless network.[2] The method includes receiving a data packet having data therein at a first device capable of wirelessly communicating with a second device.[3] The data is associated with one of a plurality of network enabled software applications executing on the first

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1 See Specification, page 1, lines 7-10.
2 See Specification, Figure 1; page 18, line 1 – page 19, line 17.
3 See Specification, page 12, lines 4-7; page 18, line 16 – page 19, line 5; page 22, line 7 – page 23, line 6; and page 31, lines 1-10.

device[4] and generating display information in response to processing by the one of the plurality of network enabled software applications for use by the second device in producing a display on the second device.[5] The first and second devices perform wireless transmissions to one another through a wireless router.[6] Performing wireless transmissions to one another through the wireless router comprises the step of providing a first wireless communication link between the first device and the wireless router in accordance with a first protocol[7] and providing a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol.[8]

The current invention, as set forth currently in Independent Claim 33, relates to a method of processing a packet in a wireless network.[9] The method includes wirelessly receiving a data packet having data therein at a first device capable of wirelessly communicating with a second device.[10] The data is employed in producing a display on the first device for a one of a plurality of network enabled software applications executing on the second device[11] and generating display information in response to processing by the one of the plurality of network enabled software applications for use by the first device.[12] The first and second devices perform wireless transmissions to one another through a wireless router.[13] Performing wireless transmissions to one another through the wireless

4 See Specification, page 12, lines 9-10; page 20, line 15 – page 21, line 3; and page 23, lines 7-16.
5 See Specification, page 9, lines 10-15; page 26, line 15 – page 27, line 9; and page 32, line 13 – page 33, line 9.
6 See Specification, reference number #120 on Figure 1; page 23, lines 7-16; page 20, line 15 – page 21, line 3; and page 33, lines 3-9.
7 See Specification, page 19, lines 1-10; page 23, lines 7-16; and page 44, lines 3-10.
8 See Specification, page 19, lines 1-10; page 23, lines 7-16, page 35, lines 3-9; and page 44, lines 3-10.
9 See Specification, Figure 1; page 18, line 1 – page 19, line 17.
10 See Specification, page 12, lines 4-7; page 18, line 16 – page 19, line 5; page 22, line 7 – page 23, line 6; and page 31, lines 1-10.
11 See Specification, page 9, lines 10-15; page 26, line 15 – page 27, line 9; and page 32, line 13 – page 33, line 9.
12 See Specification, page 12, lines 9-10; page 20, line 15 – page 21, line 3; and page 23, lines 7-16.
13 See Specification, reference number #120 on Figure 1; page 23, lines 7-16; page 20, line 15 – page 21, line 3; and page 33, lines 3-9.

router comprises the step of providing a first wireless communication link between the first device and the wireless router in accordance with a first protocol[14] and providing a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol.[15]

The current invention, as set forth currently in Independent Claim 36, relates to a computer system in a wireless network, the computer system for processing a packet in a wireless network.[16] The computer system includes a first device.[17] The computer system further includes a second device capable of wirelessly communicating with the first device and wirelessly receiving a data packet having data therein from the first device.[18] The second device employing the data to generate a display on the second device associated with a one of a plurality of network enabled software applications executing on the first device.[19] The first and second devices perform wireless transmissions to one another through a wireless router.[20] Performing wireless transmissions to one another through the wireless router comprises the step of providing a first wireless communication link between the first device and the wireless router in accordance with a first protocol[21] and providing a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol.[22]

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14 See Specification, page 19, lines 1-10; page 23, lines 7-16; and page 44, lines 3-10.
15 See Specification, page 19, lines 1-10; page 23, lines 7-16, page 35, lines 3-9; and page 44, lines 3-10.
16 See Specification, Figure 1; page 18, line 1 – page 19, line 17.
17 See Specification, reference number 140 on Figure 1; and page 19, lines 1-2..
18 See Specification, reference numbers 110, 112 and 116; page 12, lines 4-7; page 18, line 16 – page 19, line 5; page 22, line 7 – page 23, line 6; and page 31, lines 1-10.
19 See Specification, page 9, lines 10-15; page 12, lines 9-10; page 20, line 15 – page 21, line 3; page 23, lines 7-16; page 26, line 15 – page 27, line 9; and page 32, line 13 – page 33, line 9.
20 See Specification, reference number #120 on Figure 1; page 23, lines 7-16; page 20, line 15 – page 21, line 3; and page 33, lines 3-9.
21 See Specification, page 19, lines 1-10; page 23, lines 7-16; and page 44, lines 3-10.
22 See Specification, page 19, lines 1-10; page 23, lines 7-16, page 35, lines 3-9; and page 44, lines 3-10.

The current invention, as set forth currently in Independent Claim 37, relates to a computer readable medium whose contents cause the processing of a packet in a wireless network.[23] The computer readable medium causes the processing of a packet in a wireless network by receiving a data packet having data therein at a first device capable of wirelessly communicating with a second device.[24] The data is associated with one of a plurality of network enabled software applications executing on the first device[25] and generating display information in response to processing by the one of the plurality of network enabled software applications for use by the second device in producing a display on the second device.[26] The first and second devices perform wireless transmissions to one another through a wireless router.[27] Performing wireless transmissions to one another through the wireless router comprises the step of providing a first wireless communication link between the first device and the wireless router in accordance with a first protocol[28] and providing a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol.[29]

The current invention, as set forth currently in Independent Claim 40, relates to a computer-readable medium whose contents transforms a computer system into a packet processing system in a wireless network.[30] The computer-readable medium includes a wireless packet receiving subsystem

23 See Specification, Figure 1; page 18, line 1 – page 19, line 17.
24 See Specification, page 12, lines 4-7; page 18, line 16 – page 19, line 5; page 22, line 7 – page 23, line 6; and page 31, lines 1-10.
25 See Specification, page 12, lines 9-10; page 20, line 15 – page 21, line 3; and page 23, lines 7-16.
26 See Specification, page 9, lines 10-15; page 26, line 15 – page 27, line 9; and page 32, line 13 – page 33, line 9.
27 See Specification, reference number #120 on Figure 1; page 23, lines 7-16; page 20, line 15 – page 21, line 3; and page 33, lines 3-9.
28 See Specification, page 19, lines 1-10; page 23, lines 7-16; and page 44, lines 3-10.
29 See Specification, page 19, lines 1-10; page 23, lines 7-16, page 35, lines 3-9; and page 44, lines 3-10.
30 See Specification, Figure 1; page 18, line 1 – page 19, line 17.

that receives, via wireless transmission from an external device, a data packet having data therein.[31]

Further, the computer-readable medium includes a data association subsystem that associates the data with a one of a plurality of network enabled software applications which is executing on the packet processing system[32] and which generates, for wireless transmission to the external device, display information in response to processing by the one of the plurality of network enabled software applications for use by the external device to produce a display on the external device.[33] The packet processing system and the external device perform wireless transmissions to one another through a wireless router.[34] Performing wireless transmissions to one another through the wireless router comprises the step of providing a first wireless communication link between the first device and the wireless router in accordance with a first protocol[35] and providing a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol.[36]

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31 See Specification, page 12, lines 4-7; page 18, line 16 – page 19, line 5; page 22, line 7 – page 23, line 6; and page 31, lines 1-10.
32 See Specification, page 12, lines 9-10; page 20, line 15 – page 21, line 3; and page 23, lines 7-16.
33 See Specification, page 9, lines 10-15; page 26, line 15 – page 27, line 9; and page 32, line 13 – page 33, line 9.
34 See Specification, reference number #120 on Figure 1; page 23, lines 7-16; page 20, line 15 – page 21, line 3; and page 33, lines 3-9.
35 See Specification, page 19, lines 1-10; page 23, lines 7-16; and page 44, lines 3-10.
36 See Specification, page 19, lines 1-10; page 23, lines 7-16, page 35, lines 3-9; and page 44, lines 3-10.

Grounds of Rejection to be Reviewed on Appeal

1. Are Claims 11-22, 30, 32, 33, 36, 37, 40, 45 and 46 unpatentable under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Number 6,397,259 to Lincke et al.,?

2. Are Claims 11-22, 30, 32, 33, 36, 37, 40, 45 and 46 unpatentable under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,356,905 to Gershman et al., in further view of U.S. Patent Number 6,108,314 to Jones et al.,?

As detailed below, the Examiner has improperly applied U.S. Patent Number 6,397,259 to Lincke et al., to Claims 1-22, 30, 32, 33, 36, 37, 40, 45 and 46. Specifically, the §102 rejection based on this reference is not proper and is without basis, and that the Examiner has failed to state a prima facie case as to how U.S. Patent Number 6,397,259 to Lincke et al., anticipates, under 35 U.S.C. § 102(e), each and every element of the claims. Further, the Examiner has improperly applied U.S. Patent 6,356,905 to Gershman et al., and U.S. Patent Number 6,108,314 to Jones et al., references to Claims 1-22, 30, 32, 33, 36, 37, 40, 45 and 46. Specifically, the §103 rejections based on ,356,905 to Gershman et al., and U.S. Patent Number 6,108,314 to Jones et al., are not proper and are without basis.

ARGUMENT

Stated Grounds of Rejection

The rejections outstanding against the Claims are as follows:

1.   In the April 04, 2008 Office Action, Claims 1-22, 30, 32, 33, 36, 37, 40, 45 and 46 were rejected as unpatentable under under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Number 6,397,259 to *Lincke et al.,* (hereinafter *"Lincke"*)..

2.   In the April 04, 2008 Office Action, Claims 1-22, 30, 32, 33, 36, 37, 40, 45 and 46 were rejected as unpatentable under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,356,905 to *Gershman et al.,* (hereinafter *"Gershman"*) in further view of U.S. Patent Number 6,108,314 to *Jones et al.,* (hereinafter *"Jones"*)..

In order to prevail, Appellants must first show that the Examiner has improperly cited *Lincke* in support of the 35 U.S.C. § 102 rejection, and further show that the Examiner's application of *Gershman* and *Jones* in support of the 35 U.S.C. § 103 rejection is baseless. As such, a brief discussion of the relevant rules and recent court decisions affecting a proper rejection under 35 U.S.C. § 102 and 35 U.S.C. § 103 follows.

Legal Standards

Rejections under 35 U.S.C. §102(e)

MPEP §2131 specifies that:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § **2131.02**. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a **35 U.S.C. 102** rejection. See **MPEP § 2131.01**.

Under 35 U.S.C. § 102(e), MPEP §2131.01, the Examiner may combine another reference, which further explains that:

> Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:
> (A) Prove the primary reference contains an "enabled disclosure;"
> (B) Explain the meaning of a term used in the primary reference; or
> (C) Show that a characteristic not disclosed in the reference is inherent.

In order to meet the second criterion for introducing additional references, MPEP §2131.01 II specifies that:

> Extrinsic evidence may be used to explain but not expand the meaning of terms and phrases used in the reference relied upon as anticipatory of the claimed subject matter.

In order to meet the third criterion for introducing additional references, MPEP §2131.01 III specifies that

> "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed.Cir. 1991)

In the present application, the reference provided by the Examiner does not describe each and every element of the claims of the instant application, expressly or inherently. Accordingly, the Examiner has failed to provide a single prior art reference that anticipates Appellants' present inventive concept as defined by the claims.

Decisions Regarding a Finding of Anticipation.

With respect to anticipation, a claimed invention is unpatentable if the differences between it and the prior art are such that "one skilled in the art would reasonably understand or infer from the prior art reference's teaching that every claim [limitation] was disclosed in that single reference."[37] Determining whether a prior art reference discloses each and every limitation of the claim, expressly

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37 *Akamai Technologies, Inc v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186, 1192 (Fed. Cir. 2003) (citing *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368 (Fed. Cir. 2003))

or inherently, is a factual question reviewed for substantial evidence. This factual question is contingent upon the proper claim construction.[38]

Proper claim construction begins with an interpretation of the meaning of the claim language. To ascertain the meaning of claims, the court considers three sources: the claims, the specification, and the prosecution history, as well as extrinsic evidence.[39] In *Lacks Industries, Inc. v. McKechnie Vehicle Components USA, Inc*, 322 F.3d 1335 (Fed. Cir. 2003) the Court noted that, in regards to claim construction:

> ". . . we begin with an examination of the intrinsic evidence, *i.e.*, the claims, the other portions of the specification, and the prosecution history (if in evidence). *Gart v. Logitech, Inc., 254 F.3d 1334, 1339, 59 USPQ2d 1290, 1293-94 (Fed. Cir. 2001)*. Courts may also review extrinsic evidence in construing a claim. *E.g., Spectrum Int'l, Inc. v. Sterilite Corp., 164 F.3d 1372, 1378, 49 USPQ2d 1065, 1068 (Fed. Cir. 1998)*. Additionally, dictionary definitions, although extrinsic, may be used to establish a claim term's ordinary meaning. *Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1584 n.6, 39 USPQ2d 1573, 1580 n.6 (Fed. Cir. 1996).*"[40]

The court determines if an inventor imparted a novel meaning to the term.41 As such, the claims are read in light of the specification.42 *Victronics* further states:

> "the specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication. As we have repeatedly stated, "claims must be read in view of the specification, of which they are a part." The specification contains a written description of the invention which must be clear and complete enough to enable those of ordinary skill in the art to make and use it. Thus, the specification is always relevant to the claim construction

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38 *Id.*
39 *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995)
40 *Lacks Industries, Inc. v. McKechnie Vehicle Components USA, Inc*, 322 F.3d 1335, 1341 (Fed. Cir. 2003)
41 See generally, *Omega Eng'g v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003)
42 *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)

analysis. Usually, it is dispositive; it is the single best guide to the meaning of the disputed term."[43]

However, during examination, it is well recognized that "the patent application claims may be given their broadest interpretation consistent with the specification, in order to facilitate sharpening and clarifying the claims at the application stage."[44] Thus the patent examiner and the applicant, in the give and take of rejection and response, work toward defining the metes and bounds of the invention to be patented.[45] *Zletz* further states:

> "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."[46]

Therefore, absent evidence that a "patentee unequivocably imparted a novel meaning to [the term] or expressly relinquished claim scope during prosecution," we give the limitation its full ordinary and customary meaning." Dictionary definitions provide evidence of a claim term's "ordinary meaning."[47] Regardless of the method of construction, the construction must be consistent with the language of the claims.[48]

Once the express limitations are construed, the next step is to construe the claims for any inherent limitation. A claim limitation is inherent in the prior art if it is necessarily present in the

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43 *Id.*

44 *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984) ("The PTO broadly interprets claims during examination of a patent application since the applicant may 'amend his claims to obtain protection commensurate with his actual contribution to the art.'")

45 *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989)

46 *Id.* at 322

47 *Abbott Laboratories v. Syntron Bioresearch, Inc.*, 334 F.3d 1343, 1350 (Fed. Cir. 2003)

48 *Lacks Industries, Inc. v. McKechnie Vehicle Components USA, Inc*, 322 F.3d 1335, 1343 (Fed. Cir. 2003)

prior art, not merely probably or possibly present.[49] Anticipation may be established if a missing claim element, although not explicitly present in the reference, is necessarily inherent in it.[50] Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.[51] Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristic or functioning of the prior art.[52] The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient. However, a gap in a reference may be filled with recourse to extrinsic evidence.[53] However, if extrinsic evidence is offered, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the asserted anticipatory reference."[54]

Anticipation is established if every element of a properly construed claim is present in a single prior art reference. There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.[55] Therefore, a rejection for anticipation under § 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.[56]

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49 *Rosco v. Mirror Lite*, 304 F.3d 1373, 1380 (Fed. Cir. 2002).
50 See *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999).
51 *Id.*
52 *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, (Fed. Cir. 1999).
53 *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1267-68 (Fed. Cir. 1991).
54 *Id.*
55 *Biacore v. Thermo Bioanalysis Corp.*, 79 F. Supp. 2d 422, 459 (D. Del. 1999)
56 *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994)

Analysis of Examiner's 35 U.S.C § 102 Rejection in the Application on Appeal.

The Examiner maintains the 35 U.S.C. § 102(e) rejection of claims 1-22, 30, 32, 33, 36, 37, 40, 45 and 46 as being anticipated by *Lincke*.[57] The Examiner simply has construed Appellants' invention in a manner inconsistent with the claims and with the specification to support an anticipation rejection under 35 U.S.C. § 102. In order to establish a *prima facie* case of anticipation using *Lincke*, the Examiner must first show that the reference describes each and every element, expressly or inherently, to support a conclusion of anticipation as it relates to the entire invention. The Examiner may then provide secondary references to illustrate that the primary reference describes a gap, or inherency, in the express limitations. Since no description or teaching in *Lincke* to support the rejection has been provided, the Examiner's use of *Lincke* is conclusory.

Independent Claim 1 as rejected by *Lincke*.

In the Final Office Action mailed April 04, 2008, the Examiner maintains the 35 U.S.C. § 102 rejection of Claims 1-22, 30, 32, 33, 36, 37, 40, 45 and 46. On page 7 of the Final Office Action the Examiner states:

> Lincke discloses a system and method for transferring packet data between a first wireless web server device 140 to a second wireless device 100 via a wireless router 180. Lincke discloses the invention substantially as claimed. Taking claim 1 as an exemplary claim, Lincke discloses a method for processing a packet in a wireless network (see fig. 1), comprising: receiving a data packet having data therein at a first device (server 140) capable of wirelessly communicating with a second device (100); associating the data with a one of a plurality of network enabled software applications executing on the first device (web application executing on web server 140) and generating display information in response to processing by the one of the plurality of network enabled software

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57 See Final Office Action mailed April 04, 2006 on pages 7-10.

applications for use by the second device in producing a display on the second device (see figure 1, browser 104 running on device 100; the browser 104 displays the response wireless application 107 on the wireless device 100); and the first and second device performing wireless transmissions to one another through a wireless router (see fig. 1, wireless server 140 performs wireless transmission to wireless device 100 through a wireless router 180; the proxy 180 operates and functions as a wireless router). Lincke further teaches wherein performing wireless transmissions to one another through the wireless router further comprises, providing a first wireless communication link between the first device and the wireless router in accordance with a first wireless protocol (see CTP, col. 11), and providing a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol (see TCP/IP or HTML columns 11-12).58

As such, the Examiner is stating that *Lincke* discloses each and every element of Claim 1 of the instant application.

The Cited Reference.

In the Response dated February 04, 2008, to the Office Action dated October 03, 2007, the arguments thereof repeated herein, Appellants question whether *Lincke* anticipates or renders obvious Appellants' invention as set forth in the presented claims.

Discussion of U.S. Patent Number 6,397,259 to *Lincke, et al.*, as it relates to Claim 1.

The primary purpose of *Lincke* is to provide packet minimized communications between a wireless client and a proxy server.[59] A wireless communications device has programs for web access and two-way messaging.[60] The programs may include predefined applications that correspond to a portion of a web site served by a web server.61 The wireless device, in some embodiments, can

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58 See Final Office Action, mailed April 04, 2008, page 7.
59 See *Lincke*, Abstract.
60 See *Lincke*, col. 7, lns. 13-15.
61 See *Lincke*, col. 7, lns. 16-18.

complete a web-based information request using only one packet sent to a proxy server.[62] The proxy server is connected to the web server via the Internet.[63] The proxy server communicates to the wireless network through a private network.[64] The private network may include many servers, routers and hubs or the private network may be part of the Internet.[65] The proxy server converts Internet Protocols, such as HTTP and TCP into a form that can be used by the wireless network.[66]

Independent Claim 1 of the instant application, as currently presented, is directed to a method of processing a packet in a wireless network. The method recites receiving a data packet having data therein at a *first device capable of wirelessly communicating with a second device*.

As such, Independent Claim 1 first recites that the first device be capable of wireless communications with a second device. As Appellants have stated previously during prosecution, "[the] web server 140 is illustrated in [*Lincke*] Figure 1 as communicating with a proxy server 180 which communicates with a base station 170 – all utilizing wireline communications. The base station 170 communicates wirelessly with the communications device 100."[67] *Lincke* does disclose wireless communications between the communications device 100 and the base station 170. However, *Lincke* does not disclose wireless communications between the web server 140 and the communications device 100.[68] The web server 140 in *Lincke* has been cited by the Examiner as corresponding to the first device.[69] *Lincke* does not disclose that the web server 140 is capable of wireless communications. The Examiner has not shown how *Lincke* suggests or discloses such.

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62 See *Lincke*, col. 7, lns. 13-15.
63 See *Lincke*, reference # 172 on Figure 1; col. 10, lns. 66-67.
64 See *Lincke*, col. 11, lns. 1-5.
65 See *Lincke*, col. 11, lns. 1-13.
66 See *Lincke*, col. 11, lns. 13-25.
67 See Response mailed February 4, 2008, page 12.
68 See *Lincke*, reference numbers 172 and 190 on Figure 1; col. 9, lns. 48-53; and col. 10, ln. 66 – col. 11, ln. 7.
69 See Final Office Action mailed April 04, 2008, pages 7 and 10, paragraph 1.

The Examiner cites *Lincke*, column 12, lines 34-63, to teach receiving a data packet having

data therein at a first device (web server 140) capable of wirelessly communicating with a second

device (wireless device 100).[70] The cited portion of *Lincke* states:

> enables a user to send and receive wireless messages with other users
> that have Internet e-mail accounts.
>
> The browser 104 *[sic]* support both wireless and wireline
> connections. An effective wireless browsing solution leverages the
> use of the proxy server 180 in order to deliver satisfactory
> performance. A solution embodied in the roles established for the
> wireless communications device 100 and the proxy server 180
> dramatically reduces the amount of data that is sent between the
> wireless communications device 100 and the proxy server 180 over
> the slow wireless link. This form of browsing is referred to
> hereinafter as thin browsing.
>
> The performance of <u>wireline links, on the other hand, is high
> enough that a wireless communications device 100 can talk directly to
> a source of data such as a web content server using standard Internet
> protocols such as HTML, HTTP and TCP</u>. This is how existing
> desktop browsers work and will be referred to hereinafter as standard
> browsing.
>
> Thin browsing can be used over wireline links as well as wireless
> links. The only extra requirement is that the proxy server 180 be
> accessible to the wireless communications device 100 over the
> Internet or an intranet. Standard browsing, on the other hand, is more
> appropriately used over wireline links because of increased chattiness
> and bandwidth requirements.
>
> The browser 104 is structured as a single user-interface that runs
> either a standard browser engine or a thin browser engine. With
> either engine, the user interface essentially appears the same, and the
> way original HTML web content is interpreted and displayed will be
> almost identical. The [71] *(Emphasis added)*.

The Examiner contends that the above cited portion of *Lincke* discloses the communications

using both wireless and wireline transmission. The Examiner states "wireless device 100

communicating with the web content server TCP/HTTP or HTML the proxy server 180 which is

70 See Final Office Action, page 7 and page 10, paragraph 1.
71 See *Lincke*, col. 12, lns. 34-63.

accessed via wireless connection."[72] This is clear error as *Lincke* simply does not teach or even

suggest that the web server 140 is accessed wirelessly. In contrast, *Lincke* expressly states that, the

wireless communications exist between the wireless device 100 and the base station 170. The base

station 170 communicates to the proxy server 180. The relevant portions of *Lincke* state:

> The following describes how the elements of FIG. 1 are coupled. The wireless communications device 100 communicates with the base station 170 via wireless communications. The base station 170 is coupled to the proxy server 180 via the private network 172. The proxy server 180, and the web server 140 are all coupled to the Internet 190.[73] *(Emphasis added)*

> Turning to the query and response elements, the wireless CTP query 122 represents a compact transfer protocol (CTP) formatted query from the wireless communications device 100. The base station 170 receives this query and forwards it to the proxy server 180. The forwarded query is represented by CTP query 124. The proxy server 180 takes the CTP query 124 and converts it into one or more HTTT queries 126. The web server 140 receives this HTTP formatted query 126 and generates an HTTP response 136 that includes the HTML page 144. The proxy server 180 receives the HTTP response 136, and generates the CTP response 134. The base station 170 generates the corresponding wireless CTP response 132. The wireless communications device 100 then generates the display on the screen 101 of the example query response 107. Before describing this process in detail, the browser 104 is described in greater detail.[74] *(Emphasis added)*

The Examiner failed to provide any support that *Lincke* teaches a first device that is capable

of wirelessly communicating with the second device. This is because *Lincke* contains no teaching

for the web server communicating wirelessly to the wireless device. In the cited portion of the

specification, *Lincke* explicitly teaches that the wireless communications exist between the wireless

device 100 and the base station 170. Further, *Lincke* clearly states that "[between] the base station

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72 See Final Office Action, mailed April 04, 2008, page 10.
73 See *Lincke*, col. 9, lns. 48-53.

170 and the proxy server 180, many servers, routers, and hubs, etc. may exist."[75] Appellants question how one skilled in the art could bridge the gap from a web server, connected via the Internet to a proxy server that is coupled to a base station to wirelessly communicate with a wireless device, to a web server capable of wireless communications to the wireless device. *Lincke* contains no such teaching and the Examiner has not provided a secondary reference to indicate that such teaching would have been inherent.

Independent Claim 1 recites "associating the data with a one of a plurality of network enabled software applications executing on the first device and generating display information in response to processing by the one of the plurality of network enabled software applications for use by the second device in producing a display on the second device." Further, the claim recites "the first and second devices performing wireless transmissions to one another through a wireless router." The claim also recites that "performing wireless transmissions to one another through the wireless router further comprises providing a first wireless communication link between the first device and the wireless router in accordance with a first wireless protocol, and providing a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol."

The Examiner contends that *Lincke*, columns 11 and 12, teaches this element of Claim 1 of the instant application as well. As stated herein above, *Lincke* teaches that the proxy server 180 is coupled to the base station 170 via private network 172 and to the web server 140 via the Internet 190. It is the base station 170 that communicates wirelessly with the wireless device, not the proxy server 180. *Lincke* contains no disclosure to teach or suggest that a first wireless link is established

between a first device (web server 140) and the wireless router (proxy server 180); <u>and a second</u> <u>wireless link is established between the second device (wireless device 100) and the wireless router</u> <u>(proxy server 180)</u>. As Appellants have argued, "it is clear that the communications between the <u>web</u> server 140 and the proxy server 180 are via wireline communications over the <u>Internet</u> ... Nothing in Col. 12, lines 34-63 discloses or describes that data is transmitted wirelessly between the proxy server 180 and web server 140. Reference to other portions of Lincke confirms this."[76] The relevant portions of *Lincke* state:

Wireless Network Topology

FIG. 1 and FIG. 4 show the general topology of a wireless communications network. As shown, the wireless client 405 (in FIG. 4, the wireless communications device 100 and its software have been combined into the wireless client 405) communicates directly with the proxy server 180. The wireless client 405 does not communicate directly with the actual source of data. The source of data can be a web or mail server that has content desired by the to wireless client 405. FIG. 1 shows the Internet 190 as the source of data and the source of data will be referred to as the Internet 190 throughout this application. Using this scheme, the wireless client 405 and the proxy server 180 can use a much more efficient ("thin") protocol between themselves than used by Internet mail and web servers. On the other hand, the proxy server 180 uses standard Internet protocols (HTTP, TCP) when communicating with existing mail and web servers. The proxy server 180 acts as an agent. <u>The proxy server 180 takes</u> <u>requests from the wireless client 405, obtains the requested</u> <u>information from the Internet 190, and re-formats and sends the</u> <u>requested information back to the wireless client 405. The proxy</u> <u>server 180, acting in this manner, can hide the relatively chatty and</u> <u>bandwidth intensive protocols used by standard Internet 190 servers</u> <u>from the wireless link.</u>77 *(Emphasis added).*

When read consistently, and as understood by a person skilled in the art, it is clear that *Lincke* <u>does not</u> disclose that the data transmitted between the proxy server 180 and the web server 140 is

75 See *Lincke*, col. 9, lns. 2-3.
76 See Pre-Appeal Brief Request for Review mailed August 04, 2008, page 2.

transmitted wirelessly.[78] *Lincke* contains no such teaching and the Examiner has not provided a secondary reference to indicate that such teaching would have been inherent.

Further, the Examiner's contention that "TCP/IP or HTML" represent a second wireless protocol[79] is clear error. TCP is an Internet transport protocol as known in the art and expressly stated in *Lincke*. *Lincke* states "[i]n some embodiments, the proxy server 180 communicates over the Internet 190 using standard Internet protocols such as, TCP, HTTP, and SSL."[80] TCP/IP or HTML are not known in the art as a "wireless protocols." The Examiner has not provided a secondary reference to indicate that it would have been inherent to construe TCP as a wireless protocol. Accordingly, *Lincke* contains no disclosure for providing a first wireless communication link between the first device and the wireless router in accordance with a first wireless protocol, and providing a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol.

Conclusion

Lincke provides packet minimized communications between a wireless client and a proxy server. A proxy server is coupled to a base station for communications to a wireless device. Additionally, the proxy server is connected to a web server via the Internet (wireline). The wireless device is able to complete transactions by sending single packet communications to the proxy server.

The Examiner's position is conclusory. The Examiner states that *Lincke* would provide receiving a data packet having data therein at a first device capable of wirelessly communicating

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77 See *Lincke*, col. 17, lns. 65 – col. 18, line 21.
78 See *Lincke*, col. 11, lns. 13-15; "The proxy server 180 decompresses information from the wireless network side for use on the Internet 190 side of the proxy server 180."
79 See Final Office Action, mailed April 04, 2008, page 8.

with a second device, associating the data with one of a plurality of network enabled software applications executing on the first device and generating display information in response to processing by the one of the plurality of network enable software applications for use by the second device in producing a display on the second device; and the first and second devices performing wireless transmissions to one another through a wireless router, wherein performing wireless transmissions to one another through the wireless router further comprises providing a first wireless communication link between the first device and the wireless router in accordance with a first wireless protocol and providing a second wireless communication between the wireless router and the second device in accordance with a second wireless protocol. However, the Examiner has not directed Appellants to any teaching in *Lincke* that the first device (e.g., web server) is capable of wireless communications with the second device (e.g., wireless device) or that a wireless communication link is provided between the wireless router (e.g., proxy server) and the first device (web server). Further, the Examiner has provided no secondary reference to support his assertions that certain elements of Independent Claim 1 of the instant application are inherently taught by *Lincke*. As such, the Examiner has provided no support that *Lincke* can be interpreted as teaching "a first device capable of wirelessly communicating with a second device", "providing a second wireless communication between the wireless router and the second device in accordance with a second wireless protocol" or that *Lincke* inherently teaches that "a second wireless communication between the wireless router and the second device in accordance with a second wireless protocol." In summary, the Examiner failed to provide a *prima facie* case as to why *Lincke* anticipates Appellants' present inventive concept, as defined by Claim 1.

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80 See *Lincke*, col. 11, lns. 21-25.

Independent Claims 33, 36, 37 and 40 as rejected as being anticipated by *Lincke*.

Independent Claims 33, 36, 37 and 40 recite elements analogous to elements recited by Independent Claim 1 (used by the Examiner as exemplary). Accordingly, these claims are allowable for the same, or similar, reasons as Claim 1, discussed herein above.

Dependent Claims 2-22, 30, 32 and 45-46 as rejected as being anticipated by *Lincke*.

Claims 2-22, 30, 32 and 45-46 depend from, and further limit, independent Claim 1. These claims are allowable for at least the same reasons as independent Claim 1.

Further, Claim 45 recites "receiving a packet at the wireless router transmitted wirelessly from the first device." Thereafter, the claim recites "amplifying the packet." The claim further recites "transmitting wirelessly the amplified packet to the second device." The Examiner cites *Lincke*, column 15, lines 22-59 and column 16, wireless topology section, to teach receiving a packet at the wireless router transmitted wirelessly from the first device (web server 140) amplifying the packet and transmitting wirelessly the amplified packet to the second device (wireless device 100).[81] However, nothing in this general citation illustrates a teaching of amplifying the packet.

For example, *Lincke*, column 15, lines 22-59, teaches that a user can load applications onto the wireless device via HotSync™.[82] Thereafter, *Lincke* teaches the steps of the query process.[83] Nothing in *Lincke*, column 15, lines 22-59, teaches or suggests amplifying a packet and transmitting the amplified packet.

Further, the wireless topology section in *Lincke* is found from column 16, line 66 through column 20, line 64. However, in the wireless topology section, *Lincke* merely teaches the main

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81 See Final Office Action, pages 9-10.
82 See *Lincke*, col. 15, lns. 22-41.
83 See *Lincke*, col. 15, lns. 42-59.

components and protocols for the wireless portion of the *Lincke* system. For example, *Lincke* teaches that the proxy server 180 processes resources on IP for the wireless device. The relevant portions of *Lincke* state:

> FIG. 1 and FIG. 4 show the general topology of a wireless communications network. As shown, the wireless client 405 (in FIG. 4, the wireless communications device 100 and its software have been combined into the wireless client 405) communicates directly with the proxy server 180. The wireless client 405 does not communicate directly with the actual source of data. The source of data can be a web or mail server that has content desired by the to *[sic]* wireless client 405. FIG. 1 shows the Internet 190 as the source of data and the source of data will be referred to as the Internet 190 throughout this application. Using this scheme, the wireless client 405 and the proxy server 180 can use a much more efficient ("thin") protocol between themselves than used by Internet mail and web servers. On the other hand, the proxy server 180 uses standard Internet protocols (HTTP, TCP) when communicating with existing mail and web servers. The proxy server 180 acts as an agent. <u>The proxy server 180 takes requests from the wireless client 405, obtains the requested information from the Internet 190, and re-formats and sends the requested information back to the wireless client 405.</u> The proxy server 180, acting in this manner, can hide the relatively chatty and bandwidth intensive protocols used by standard Internet 190 servers from the wireless link.
>
> The thin protocols used between the wireless client 405 and the proxy server 180 are IP based. IP based protocols are widely used and enable the wireless client 405 to communicate with many different wireless networks. Furthermore, basing wireless client 405 and proxy server 180 processing resources on IP provides a layer of isolation and independence from the actual wireless network in use.[84]
> *(Emphasis added)*

Thus, *Lincke* teaches, and is limited to teaching, that the proxy server re-formats and sends the requested information back to the wireless device. *Lincke* contains no disclosure that the proxy server 180, or any device, amplifies the packets. Accordingly, *Lincke* does not teach each and every element as recited and arranged in Claim 45.

Additionally, Claim 46 recites "receiving a wireless transmission at the wireless router transmitted from the first device." Thereafter, the claim recites "detecting that the received wireless transmission is adequately strong to reach a known destination." Further, the claim recites "not amplifying the received wireless transmission." The Examiner collectively rejects Claim 46 with Claim 45. As such, the Examiner cites *Lincke*, column 15, lines 22-59 and column 16, wireless topology section, to teach receiving a packet at the wireless router transmitted wirelessly from the first device (web server 140) detecting that the received wireless transmission is adequately strong to reach a known destination and not amplifying the received wireless transmission.85 However, nothing in this general citation illustrates a teaching of a device detecting that the received wireless transmission is adequately strong to reach a known destination.

As stated hereinabove, with respect to Claim 45, *Lincke* does not teach or suggest amplifying a packet. The cited portions of *Lincke* merely relate to HotSync™, query steps and components and protocols. *Lincke* contains no disclosure that the proxy server 180 is capable of, or performs, detecting that the received wireless transmission is adequately strong to reach a known destination. Accordingly, *Lincke* does not teach each and every element as recited and arranged in Claim 46.

Rejections under 35 U.S.C. §103

MPEP § 2142 specifies that:

> The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

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84 See *Lincke*, col. 16, ln. 66 – col. 17, ln. 28.
85 See Final Office Action, pages 9-10.

In regard to what an examiner must show in order to establish a *prima facie* case of obviousness, MPEP § 2142 further explains that:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In regard to what an examiner must do in order to meet the first criterion for a prima facie rejection, MPEP § 2143.01 specifies that:

> Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

In the present application, the combination of references proposed by the Examiner is not supported by a proper suggestion or motivation to make each proposed modification. This means that the first criterion for a *prima facie* rejection has not been met, which in turn means the Examiner has failed to carry the burden of establishing a *prima facie* rejection. In addition, certain claim limitations are not taught or suggested by the cited combinations, which means that the third criterion for a *prima facie* rejection has not been met, and that the Examiner has further failed to carry the burden of establishing a *prima facie* rejection for this independent reason. Further, the Examiner has failed to put forth any arguments and has not provided any articulated reasoning as to how any deficiency (missing element) could be solved in a predictable manner through combination with any other reference.

Recent Decisions Affecting a Finding of Obviousness.

In re Kahn.

With respect to obviousness, a claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art."[86] Obviousness is a question of law, based upon underlying factual questions which are reviewed for clear error following a bench trial. These "underlying factual inquiries include: (1) The scope and content of the prior art; (2) The level of ordinary skill in the prior art; (3) The difference between the claimed invention and the prior art; and (4) Objective evidence of nonobviousness."[87]

In *Kahn* the Court noted that:

> "...to reject claims in an Application under § 103, an Examiner must show an unrebutted *prima facie* case of obviousness ... on appeal to the board, an Applicant can overcome a rejection by showing insufficient evidence of a *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness."[88] .

When combining references, it is well recognized that "[m]ost inventions arise from a combination of old elements and each element may often be found in the prior art."[89] "However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole."[90] *Kahn* further states:

> Rather, to establish a *prima facie* case of obviousness based on a combination of elements disclosed in the prior art, the Board must

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86 35 U.S.C. § 103(a) (2000); *In re Kahn*, 441 F.3d 977, 985 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S.1, 13-14, 86 S.Ct. 684, 15L, Ed. 2d 545, 1962)
87 *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999).
88 *Kahn*, 441 F.3d at 985
89 *In re Rouffett*, 149 F.3d 1350, 1357
90 *Kahn*, 441 F.3d at 986, citing *Rouffett*, 149 F.3d at 1355, 1357

articulate the basis on which it concludes that it would have been obvious to make the claimed invention. *Id.* In practice, this requires that the Board "explain the reasons one of the ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." *Id. at 1357-59.* This entails consideration of both the "scope and content of the prior art" and the "level of ordinary skill in the pertinent art" aspects of the Graham test.[91]

The primary test that has been put forth by the Federal Circuit is the teaching-suggestion-motivation test. *Kahn* set forth that, when there is no explanation provided by the Board to explain the motivation, or the suggestion or the teaching, that would have led a skilled artisan at the time of the invention to the claimed combination as a whole, then the court would infer that hindsight was utilized to conclude that the invention was obvious. *Kahn* relied upon the *Rouffett* case for this teaching at 1358. The "teaching-suggestion-motivation" requirement was set forth to protect against the entry of hindsight into the obviousness analysis, a problem which §103 was meant to confront. Thus, in order to establish a *prima facie* case, some explanation as to teaching, suggestion, or motivation of each of the references and how they can be combined is required.

Although *Kahn* sets forth the teaching-suggestion-motivation test, there is still the "analogous-art" test that must be applied, this being one test that was articulated by the Supreme Court as part of the *Graham* analysis.[92] "The analogous-art test requires that the Board show a reference is either in the field of the Applicant's endeavor or is reasonably pertinent as to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection."[93] The following was further stated by *Kahn*:

91 *Id.*
92 See *Dann v. Johnston*, 425 U.S. at 219, 226, 96 S.Ct. 1393, 47 L.Ed 2d 692 (1976).
93 *Kahn,* 441 F.3d at 987.

References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* ("It is necessary to consider the reality of the circumstances, in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))). We have explained that this test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination, and that it is meant to defend against hindsight. See *id.*; *In re Clay*, 996 F.2d 656, 659-60 (Fed. Cir. 1992).[94]

As such, the first step of analyzing the combination provided by the Examiner is to examine the references and determine if the combination satisfies the analogous-art test. The next step for determining obviousness is to analyze the teaching-suggestion-motivation test which:

> . . . picks up where the analogous art test leaves off and informs the Graham analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, [**23] or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law, see § 103(a); *Graham*, 383 U.S. at 35; *Dann*, 425 U.S. at 227-29, and helps ensure predictable patentability determinations.[95]

Even if all of the elements of a claim are disclosed in various prior art references, the long-standing rule that a claimed invention, as a whole[96], cannot be said to be obvious unless there is some reason or motivation given in prior art why someone would have been prompted to combine the teachings or the references.[97] The prior art itself may suggest desirability of a combination, or the

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94 *Kahn*, 441 F.3d at 987
95 *Id.*
96 *In re Hiraro*, 535 F.2d, 67, (C.C.P.A. 1966).
97 *In re Regel*, 526 F.2d, 1399 (C.C.P.A. 1975); *In re Bond*, 910 F.2d, 831, (Fed. Cir. 1990).

motivation may come from other sources (for example, economic factors).[98] Thus, the motivation to combine the relevant art or teachings does not have to be found explicitly in the prior art but, rather, can be implicit thereto. "However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."[99] The purpose of such requirement is to ensure "due process and non-arbitrary decision making", as it is in § 103.[100]

Kahn articulated the considerations for motivation when analyzing obviousness. The Court stated "the problem examined is not the specific problem solved by the invention, but the general problem that confronted the inventor before the invention was made."[101] In the reference in *Cross*, the quote that was cited by the Court[102] was that "one of ordinary skill in the art need not see the identical problem addressed in the prior art reference to be motivated to apply its teachings." As to motivation, the Courts upheld that the evidence of motivation to combine the prior art references "may flow from the prior art references themselves, knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved."[103] *Kahn* summarized the motivation-suggestion-teaching test as follows:

> Therefore, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in

98 See e.g. *In re Clinton*, 527 F.2d 1226 (C.C.P.A. 1976); *Cable Elec. Prods., Inc. v. Genmart, Inc.*, 77 F.2d, 1015 (Fed. Cir. 1985).

99 *Kahn*, 441 F.3d at 998 referring to *Lee*, 277, F.3d at 1343-46 and *Rouffett*, 149 F.3d at 1355-59. It is noted that the Supreme Court in the recently decided case, *KSR International Co. v. Teleflex Inc, et al.*, 127 S. Ct. 1727 (2007) cited this specific language at page 1741 therein.

100 *Id.* referring to *Lee*, 277, F.3d at 1343-46 and *Rouffett*, 149 F.3d at 1355-59.

101 *Id.* referring to *Cross Medical Products, Inc. v. Metronics Sofamore Danek, Inc.*, 424 F.3d 1293, 1323 (Fed. Cir. 2005).

102 *Cross*, 424 F.3d at 1323.

103 *Medichem S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir 2006), quoting *Brown and Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d, 1120, 1125 (Fed. Cir. 2000).

the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. See *Cross Med. Prods.*, 424 F.3d at 1321-24. From this it may be determined whether [**26] the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art–i.e., the understandings and the knowledge of persons having ordinary skill in the art at the time of the invention–support the legal conclusions of obviousness. See *Princeton Biochemicals*, 411 F.3d at 1338 (pointing to evidence supplying detailed analysis of the prior art and the reasons one of ordinary skill would have possessed the knowledge and motivation to combine).104

In *Alza Corporation v. Mylan Laboratories, Inc.*, 464 F.3d 1286 (Fed. Cir. 2006), the Federal Circuit has responded to arguments made during pendency of the recently decided Supreme Court case, *KSR International Co v. Teleflex Inc, et al.*, 127 S. Ct. 1727 (2007) and has spelled out its law on obviousness, insisting that it is in harmony with Supreme Court precedent.

In the facts of this case, *Alza* sued Mylan for infringement of its patent (6,124,355) under 35 U.S.C. §271(e)(2) after Mylan sought FDA approval to market a generic version of oxybutynin, a drug used to treat urinary incontinence. The Federal Circuit affirmed the obviousness and non-infringement decisions of the district court.

In the process, Judge Arthur Gajarsa dedicated five pages of his opinion to then outline the Federal Circuit's law on obviousness, responding to many arguments made in the then pending Supreme Court case of *KSR Int'l Co. v. Teleflex, Inc.* (U.S. No. 04-1350). KSR and many amici, including the U.S. government, have challenged the Federal Circuit rule that proof of obviousness must include a showing of a "teaching, suggestion, or motivation" to combine the prior art elements of the claimed invention. *KSR* and others have said that this requirement is too rigid and is

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104 *Kahn*, 441 F.3d at 988.

inconsistent with Supreme Court decisions issued since *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

Judge Gajarsa wrote the following in his *Alza* opinion:

> This requirement has been developed consistent with the Supreme Court's obviousness jurisprudence as expressed in *Graham* and the text of the obviousness statute that directs us to conduct the obviousness inquiry "at the time the invention was made" 35 U.S.C. § 103. As we explained in [*In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006)],
>
> > The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the *Graham* analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law . . .
>
> 441 F.3d at 987. We further explained that the "motivation to combine" requirement "[e]ntails consideration of both the 'scope and content of the prior art' and 'level of ordinary skill in the pertinent art' aspects of the *Graham* test." *Id.* at 986.
>
> At its core, our anti-hindsight jurisprudence is a test that rests on the unremarkable premise that legal determinations of obviousness, as with such determinations generally, should be based on evidence rather than on mere speculation or conjecture. Our court's analysis in *Kahn* bears repeating:
>
> > A suggestion, teaching, or motivation to combine the relevant prior art teachings *does not have to be found explicitly in the prior art*, as "the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references....
> > The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be *some* articulated reasoning with *some* rational underpinning to support the legal conclusion of obviousness. This requirement is as much rooted in the Administrative Procedure Act [for our review of

Board determinations], which ensures due process and non-arbitrary decision making, as it is in § 103.

441 F.3d at 987-88 (quoting *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000)) (citations omitted) (emphases added). There is flexibility in our obviousness jurisprudence because a motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires an actual teaching to combine before concluding that one of ordinary skill in the art would know to combine references. This approach, moreover, does not exist merely in theory but in practice, as well. Our recent decisions in *Kahn* and in [*Cross Med. Prods., Inc., v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293 (Fed. Cir. 2005)] amply illustrate the current state of this court's views.[105]

KSR

The recently issued Supreme Court Case in *KSR* held that the Federal Circuit's Teaching, Suggestion or Motivation (TSM) test to combine known elements in order to show that the combination is obvious is too rigid. The Court reinforced its position that analysis under *Graham* has been reaffirmed. The Court indicated that its holding was that a "patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men."[106] The Court stated that this was a "principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."[107] The Court further went on to indicate that there were three cases that illustrated the application of this doctrine of predictability. The first case was *United States v. Adams*, 383 U.S. 39, 40 (1966). In discussing this case, the Court noted that it had "relied upon the corollary principal that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-

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105 *Alza Corporation v. Mylan Laboratories, Inc.*, 464 F.3d 1286, 1290 (Fed. Cir. 2006).
106 *KSR*, 127 S. Ct. 1727, 1739 (2007), Citing *Great Atlantic & Pacific Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950).

obvious."[108] In the second case, *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969), the Court reiterated "while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented."[109] In the third case, *Sakraida v. AGPro, Inc.*, 425 U.S. 273 (1976), the Court stated that "when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious."[110]

The Court summarized these three cases as follows:

> The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. *If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability.* For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson's-Black Rock* are illustrative-a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.[111] (Emphasis added.)

The Court recognized that following the above stated principals might involve more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement."[112] The Court noted that it might "be necessary for a Court to look to interrelated teachings of multiple patents; the effects of demands known to the

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107 *Id.*
108 *Id.* at page 1740.
109 *Id.*
110 *Id.* at page 1740 Citing *Sakradia* at 282.
111 *KSR*, 127 S. Ct. at page 1741.
112 *Id.*

design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent that issued."[113] However, the Court also noted that the analysis should be "made explicit" citing *Kahn* wherein it stated that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reason with some rational underpinning to support the legal conclusion of obviousness."[114] The Court noted that, however, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ."[115]

Although the Court in this opinion rejected the rigidity of the TSM test, there was some reference to the decision in *Alza* wherein the Court noted the Federal Circuit's position that "there is flexibility in our obviousness jurisprudence because the motivation may be found *implicitly* in the prior art. We do not have a rigid test that requires an actual teaching to combine . . . ," citing *Alza*, 464 F.3d at 1291.[116] However, the Court also noted that the *Alza* decision was not before it and that, although they may describe an analysis more consistent with the Court's earlier precedence, the Court of Appeals would have to consider the current decision in view of its future cases.

<u>Analysis of the Examiner's 35 U.S.C § 103 Rejection in the Application on Appeal.</u>

The Examiner stated in the Final Office Action dated April 04, 2008:

> It would have been readily apparent at the time the invention was made given the teachings of Gershman for transmitting over the Internet and/or the Intranet that network access system enables access

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113 *Id.*
114 *Id.*
115 *Id.*
116 *Id.* at page 1743.

to mobile computer comprising at least interconnecting devices such as routers, gateways, bridges, hubs, switches, and routers *[sic]* forming a computer network and/or a collection of computer networks, e.g. *[sic]* the Internet. Perkins *[sic]* exemplifies where mobile computer communicate *[sic]* with one another through mobile/wireless routers.

Jones, in the same field of endeavor, teaches a system and method for mobile computer or devices to communicate over a wireless using a plurality of routers (see home network 10, laptop 11, content provider 55 connected via wireless network using wireless routers 30, 32). Therefore, It *[sic]* would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Garshman *[sic]* in view of Jones by implementing the system using wireless routers because doing so would have enabled the Garshman's *[sic]* disclosure to operate with less amount of turn-around time. One of ordinary skill in the art would have been motivated to modify Garsham in view *[sic]* Jones, since Jones suggests that the use of wireless routers in a system similar to that of Garshman can reduce the processing turn-around time between content servers and mobile devices. The combination of Jones and Garshman does not explicitly show that the first and second devices performing wireless transmissions to one another through a wireless router, wherein performing wireless transmissions to one another through the wireless router further comprises, providing a first wireless communication link between the first device and the wireless router in accordance with a first wireless protocol, and providing a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol. However, Jones suggests the process of providing a wireless communication link between the first device and the wireless router in accordance with a first protocol (see col. 2, lines 35-53, broadband channel); providing a wireless communications link between the wireless router and the second device in accordance with a second protocol (see col. 2, lines 54-67, satellite links, FDDI wireless interface 231). Dolan *[sic]* in the same field of endeavor, discloses that the process of providing a wireless communication link between the first device and the wireless router in accordance with a first wireless protocol and providing a wireless communication link between the wireless router and the second device in accordance with a second protocol is old and known in the art. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combination of Jones and Garshman in view of Dolan to arrive at the claimed invention,

because doing so would have enabled the combination of Jones and Garshman to implement the processing in a flexible manner as suggest by Dolan (Abstract).[117]

Here, the Examiner simply has broken Appellants' invention into its component parts and then attempted to find a prior art reference corresponding to each component to support an obviousness rejection under 35 U.S.C. § 103. In order to establish a *prima facie* case of obviousness using the combination of *Gershman* and *Jones*, the Examiner must first show that each of the references is analogous prior art and then provide an explanation as to whether the overall disclosures of the references, the teachings therein and the suggestions associated therewith, in addition to the level of skill in the art, support a conclusion of obviousness as it relates to the entire invention. The Examiner's combination of *Gershman* and *Jones* (and additional combination with *Dolan*) is conclusory, and no articulated reasoning with some rational underpinning to support the combination has been provided. Further, support for the combination is based on hindsight and the combination is improper.

Independent Claim 1 as rejected as being unpatentable over *Gershman* further in view of *Jones*.

In the Final Office Action mailed June 22, 2007, the Examiner maintains the 35 U.S.C. § 103 rejection of Claims 1-22, 30, 32, 33, 36, 37, 40, 45 and 46. On page 2 of the Final Office Action the Examiner states:

> As per claim 1, Gershman teaches the process of receiving a data packet having data at a first device capable of communicating with a second device; associating the data with one of a plurality of software applications executing on the first device; generating information in response to processing by the one software application; receiving said information on the second device and producing a display on the

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117 See Final Office Action, mailed June 22, 2007, page 12.

117 See Final Office Action, mailed June 22, 2007, page 12.

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second device; and wherein the first and" *[sic]* second device performing transmissions to one another simultaneously (column 34, liens 56-64, column 50, lines 17-55; column 51, lines 1-18 and column 56, line 5 –column 57, line 4); communication over the networks such as the Internet and/or Intranet, however the applied reference does not explicit disclose the use of a wireless router.

...

Jones, in the same field of endeavor, teaches a system and method for mobile computer or devices to communicate over a wireless using a plurality of routers (see home network 10, laptop 11, content provider 55 connected via wireless network using wireless routers 30, 32).

... Dolan *[sic]* in the same field of endeavor, discloses that the process of providing a wireless communication link between the first device and the wireless router in accordance with a first wireless protocol and providing a wireless communication link between the wireless router and the second device in accordance with a second protocol is old and known in the art. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combination of Jones and Garshman in view of Dolan to arrive at the claimed invention, because doing so would have enabled the combination of Jones and Garshman to implement the processing in a flexible manner as suggest by Dolan (Abstract).118

As such, the Examiner is stating that the asserted combination of *Gershman* and *Jones*, further in view of a reference *Dolan*, teaches each and every element of Claim 1.

The Cited References

In the Response dated February 04, 2008, to the Office Action dated October 03, 2007, the arguments thereof repeated herein, Appellants question whether the combination of *Gershman* and *Jones* renders obvious Appellants' invention as set forth in the presented claims. Appellants note that the Examiner has asserted a combination of *Gershman* and *Jones* with a reference "Dolan",

118 See Final Office Action, mailed April 04, 2008, pages 2-4.

however, the Examiner has not provided a citation, e.g., Patent or Publication number, to identify Dolan. Accordingly, Appellants assume the Examiner is referring to U.S. Patent Number 6,396,820 to *Dolan et al.*, (hereinafter "*Dolan*"). As such, Appellants will address the arguments to the combination of *Gershman* and *Jones*, and *Dolan*.

<u>Discussion of U.S. Patent Number 6,356,905 to *Gershman, et al.*, as it relates to Claim 1.</u>

Gershman discloses a system that facilitates web-based information retrieval and display.[119] *Gershman* discloses a wireless device 2602, 2713 that generates and transmits a search query message to the wireless server 2606, 2722.[120] The wireless server 2606, 2722 determines the appropriate third party service provider (communicatively coupled to the server 2606, 2722 via the internet or extranet) and transmits a new message thereto.[121] The third party service provider performs the appropriate service and transmits the result back to the server 2606, 2722.[122] The server 2606, 2722 forms a message based on the result and transmits this message to the wireless device 2602, 2713.[123]

The Examiner concedes that *Gershman* does not teach a wireless router. Nonetheless, the Final Office Action rejects Independent Claim 1, contending that the secondary citation to *Jones* provides this necessary disclosure.[124] This contention is respectfully traversed.

Further, *Gershman* does teach "associating the data with a one of a plurality of network enabled software applications <u>executing on the first device</u> and generating display information in response to processing by the one of the plurality of network enabled software applications for use by

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119 See *Gershman*, Abstract.
120 See *Gershman*, col. 50, lns. 17-40; and col. 56, lns. 9-52.
121 See *Gershman*, col. 50, lns. 40-46; and col. 56, lns. 9-52.
122 See *Gershman*, col. 50, lns. 46-49; and col. 56, lns. 9-52.
123 See *Gershman*, col. 50, lns. 49-52; and col. 56, lns. 9-52.

the second device in producing a display on the second device" as recited by currently presented independent Claim 1.

Gershman teaches that the third party service provider and content providers 2730, not the wireless server 2606, 2722, execute the software application. Though *Gershman* describes that this configuration "allows the Electronic Valet 2602 to execute many different software applications without the need for a large amount of internal memory and storage capacity",[125] *Gershman* discloses that the third party service or content providers 2730 perform the software execution - not the wireless server 2606, 2722. Moreover, as argued in prosecution, Appellants' network enabled software applications, as described in the specification of the instant application, "do not appear equivalent to the intelligent agents 2724, customer intelligence 2726 or customer data 2728 in the Mobile Portal 2712."[126]

Accordingly, *Gershman* does not teach "associating the data with a one of a plurality of network enabled software applications executing on the first device and generating display information in response to processing by the one of the plurality of network enabled software applications for use by the second device in producing a display on the second device." Thus, *Gershman* does not disclose, or render obvious, each and every element as recited and arranged in the claims of the instant application.

Additionally, the Examiner concedes that *Gershman* does not teach the first and second devices performing wireless transmissions to one another through a wireless router, wherein performing wireless transmissions to one another through the wireless router further comprises,

124 See Final Office Action, mailed April 04, 2008, pages 3 and 4.
125 See *Gershman*, col. 50, lns. 34-47.
126 See Response mailed February 04, 2008, page 15.

providing a first wireless communication link between the first device and the wireless router in accordance with a first wireless protocol, and providing a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol. Nonetheless, the Final Office Action rejects Independent Claim 1, contending that the citation to *Dolan* provides this necessary disclosure.[127] This contention is respectfully traversed.

Discussion of U.S. Patent Number 6,108,314 to *Jones, et al.*, as it relates to Claim 1.

The Examiner provided *Jones* to cure the deficiencies of *Gershman*. *Jones* teaches communication system 100 comprising subscriber devices 10, 11, 12, 13, 14, 15 and a number of routers 30, 31, 32, 33 for interconnection via a Time Division Duplex (TDD) system and connection to the Internet.[128] A device requests registration to a wireless router during an idle TDD frame.[129] The router forwards the request to a network management module 50.[130] The network management module responds to the registration requests and authorizes the router to initiate communications with the device.[131] Thereafter, wireless routers can route communications, over communications links, to other devices connected to that router or devices connected to another, adjacent router.[132] Additionally, the wireless router can route communications from a subscriber to the Internet 40.[133]

The Examiner states that it would have been obvious for one skilled in the art to combine *Gershman* with *Jones* because "doing so would have enabled the Garshman's *[sic]* disclosure to operate with less amount of turn around time." However, the Examiner fails to provide any

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127 See Final Office Action, mailed April 04, 2008, pages 3 and 4.
128 See *Jones*, Figure 1; col. 1, lns. 16-39; and col. 2, lns. 35-60.
129 See *Jones*, col. 3, lns. 1-8.
130 See *Jones*, col. 3, lns. 8-13..
131 See *Jones*, col. 3, lns. 13-21..
132 See *Jones*, col. 3, lns. 21-27.
133 See *Jones*, col. 3, lns. 27-30.

articulated reasoning with some rational underpinning to support that the specific use of the wireless routers in *Jones* should be combined with *Gershman*. The Examiner's contention that using wireless routers would enable *Gershman* to operate with less amount of turnaround time does not appear to make sense, as injecting another component within the network through which wireless communications must flow between two wireless devices (particularly a wireless server and a wireless device) would actually increase turn around time.

Appellants' claimed invention allows a wireless device to operate wirelessly in a client-server model, and the inclusion of a wireless router extends the communications range. *Gershman* and *Jones* (and *Dolan*), taken singularly or in combination, do not describe this.

Clearly, *Jones* only teaches, and is limited to such teaching, that turn around time is a problem caused by the time it takes wireless subscriber devices to switch from received to transmit only in TDD systems. *Jones* contains no disclosure that adding a wireless router between a *Gershman* point-to-point protocol network would reduce the processing turn around time between content servers and mobile devices.[134] The Examiner provided no citation or support as to where such a teaching, if one existed, could be found. Thus, *Jones* does not provide a disclosure that remedies the aforementioned, conceded deficiency in the primary citation to *Gershman*.

Further, *Gershman* and *Jones*, taken singularly or in combination, do not teach the first and second devices performing wireless transmissions to one another through a wireless router, wherein performing wireless transmissions to one another through the wireless router further comprises, providing a first wireless communication link between the first device and the wireless router in accordance with a first wireless protocol, and providing a second wireless communication link

between the wireless router and the second device in accordance with a second wireless protocol. The Examiner concedes that the combination of *Gershman* and *Jones* does not disclose the utilization of two different wireless protocols.[135] Nonetheless, the Examiner contends that *Jones* suggests using two different wireless protocols as recited – citing Jones, Col. 2 lines 35-67 (referencing a "broad band" channel and "satellite links, FDDI wireless interface 231").[136] However, to the contrary, *Jones* discloses (1) broad-band radio channels between the wireless subscriber devices and the wireless routers 30, 31, 32 and 33, and (2) wireless communications between the respective wireless routers (see Figure 1). *Jones* describes in an alternative embodiment that each (as opposed to only two) of the wireless routers 30, 31, 32 and 33 are connected directly to the global Internet 40 (wireline connections), and in yet another alternative embodiment, the wireless links between wireless routers (links 34, 35, 36 and 37) may be replaced with land-based links (using FDDI, 100Base-X or ATM networks – all <u>wireline</u> communication protocols). And still, that "satellite links" <u>may</u> be possible.

Nonetheless, as conceded by the Examiner, *Jones* still fails to describe or teach that the wireless communications between one subscriber device (first wireless device) and a wireless router uses a first wireless communications protocol and the second subscriber device (second wireless device) uses a first wireless communications protocol. It is clear that *Jones'* subscriber devices which communicate with the wireless routers use the same "broad-band" radio channel – which utilize the same wireless communications protocol since the cited portions of *Jones* fail to describe or teach anything to the contrary. Accordingly, *Gershman* and *Jones*, taken singularly or in

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134 See *Gershman*, col. 50, lns. 56-67, uses of SE wireless modem; and Examiners contention in Final Office Action mailed April 04, 2008, page 3.
135 See Final Office Action, mailed April 04, 2008, pages 3 and 4.

combination, fail to disclose, teach or suggest each and every element as recited in claims of the instant application.

Discussion of U.S. Patent Number 6,396,820 to *Dolan, et al.*, as it relates to Claim 1.

The Examiner provided *Dolan* to cure the deficiencies of *Gershman* and *Jones*. *Dolan* teaches control and data communications taking place between source and target base stations via a mobile switching center (MSC), and more specifically related to voice communications between two mobile units.[137] *Dolan* expressly teaches that two protocols are used by the Selection Distribution Unit (SDU) 108 of the Mobile Switching Center (MSC) 102 to communicate to each base station (BS) 110, 120.[138]

The Examiner states that "Dolan, in the same field of endeavor, discloses that the process of providing a wireless communication link between the first device and the wireless router in accordance with a first wireless protocol and providing a wireless communication link between the wireless router and the second device in accordance with a second protocol is old and known in the art."[139] Then, the Examiner concludes that "it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combination of Jones and Garshman *[sic]* in view of Dolan to arrive at the claimed invention, because doing so would have enabled the combination of Jones and Garshman *[sic]* to implement the processing in a flexible manner as suggest by Dolan (Abstract)." *Dolan* contains no such disclosure.

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136 See Final Office Action, mailed April 04, 2008, pages 3 and 4.
137 See *Dolan*, Abstract; and Figures 1, 2 and 3.
138 See *Dolan*, col. 3, lns. 31-47.
139 See Final Office Action, page 4 *(emphasis added)*.

Dolan expressly teaches that two protocols are provided by the SDU 108 to each base station 110, 102. No articulated reasoning with some rational underpinning has been provided to support how utilizing two packet based transport links to each of two base stations would be utilized in either or both of *Gershman* and *Jones*. Further, the Examiner has provided no citation nor directed Appellants to any teaching in *Dolan* where such a teaching could be found.

Dolan is not related to, and does not disclose, teach or describe, wirelessly communicating a data packet from a first device to a second device through a wireless router where the path between the first device and the wireless router utilizes a first wireless communications protocol and the path between the wireless router and the second device utilizes a second wireless communications protocol. No rational reason exists to combine *Dolan* with *Gershman* and *Jones*. Further, even if combined, the combination of *Gershman*, *Jones* and *Dolan* would not produce the invention as defined by the claims of the instant application.

Conclusion

The Examiner has failed to provide a rational teaching or suggestion to support that one skilled in the art would take the *Gershman* web-based information retrieval and display system and combine it with the *Jones* wireless router network and further combine with the two packet based transport links to each base station. *Gershman* relates to wireless devices accessing information from the Internet directly. *Jones* provides wireless routers to reduce turn around times caused by mobile devices only in a TDD system. *Dolan* teaches that a MSC sends two separate protocols to each of its base stations. The question is "why" would one skilled in the art combine the references in the manner suggested by the Examiner? The Examiner's rationale that one skilled in the art would

make the asserted combination because it would reduce the processing turn around, and implement

the processing in a flexible manner, is conclusory. The Examiner provides no evidence that there

existed a problem that required such a combination. Further, the Examiner provided no support that

the asserted combination teaches the required solution. [A] patent composed of several elements is

not proved obvious merely by demonstrating that each of its elements was, independently, known in

the prior art. [140] The Examiner has fallen prey to hindsight bias and is reading into the prior art the

teachings of the invention in issue, which is prohibited by *KSR*.[141]

> Independent Claims 33, 36, 37 and 40 as rejected as being unpatentable over the combination
>
> of *Gershman* and *Jones*.

Independent Claims 33, 36, 37 and 40 recite elements analogous to elements recited by

Independent Claim 1 (used by the Examiner as exemplary). Accordingly, these claims are allowable

for the same, or similar, reasons as Claim 1, discussed herein above.

> Dependent Claims 2-22, 30, 32 and 45-46 as rejected as being unpatentable over the
>
> combination of *Gershman* and *Jones*.

Claims 2-22, 30, 32 and 45-46 depend from, and further limit, independent Claim 1. These

claims are allowable for at least the same reasons as independent Claim 1, discussed herein above.

Further, Claim 45 recites "receiving a packet at the wireless router transmitted wirelessly

from the first device." Thereafter, the claim recites "amplifying the packet." The claim further

recites "transmitting wirelessly the amplified packet to the second device." The Examiner cites

Jones, column 3, line 49 to column 4, line 26, amplifying the packet and transmitting wirelessly the

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140 *KSR*, 127 S. Ct. at page 1742

amplified packet to the second device (wireless device 100).[142] However, *Jones* contains no

disclosure that illustrates a teaching of amplifying the packet.

The cited portions *Jones* teach, and are limited to teaching, how the wireless router routes and

transfers packets. The cited portions state:

> The transmitter and receiver cards 210, 211, 200 and 201 are
> connected to a wireless router bus 202. Also connected to the bus are
> a controller and one or more interface cards for linking the wireless
> router to other wireless routers or to the global Internet or other
> networks. These interface cards include a wireless network interface
> 230, a FDDI network interface 231, a 100Base-X interface 232, an
> ATM network interface 233, and another network interface card 234.
> The network interface cards 233 and 234 perform the tasks of ATM
> layer segmentation and reassembly (SAR), and <u>forwarding, or layer 3
> routing and forwarding, with or without bridging. Packets or frames
> are transmitted to the appropriate network after these functions are
> performed</u>. The wireless router 30 has a central controller 221 with a
> memory 222. Each of the cards 200 or 210 or 221 or 230 to 234 also
> has a processor or controller (e.g. a microprocessor or an ASIC). The
> various controllers or processors have loaded therein software that
> performs certain functions as follows. The controller 221 performs
> routing protocols, signaling functions, MAC protocol scheduling and
> spectrum management and it includes SNMP agents. The wireless
> transmitter cards 210 and 211 perform MAC protocol formatting and
> processing and perform spectrum management. The wireless receiver
> cards 200 and 201 perform MAC protocol formatting and processing,
> spectrum management, IP, MPEG and/or ATM forwarding. The
> wireless network interface 230 performs MPEG forwarding and
> spectrum management for the link 34. The FDDI network interface
> 231 performs IP forwarding, as does the 100Base-X interface 232.
> The ATM network interface 233 performs IP forwarding, ATM
> forwarding and MPEG forwarding.
>
> In operation, different types of data need to be transferred
> between the various interface cards of the wireless router 30 and the
> various in-home devices. For example, Internet Protocol (IP) needs
> to be transferred between the computer devices (not shown) in the
> subscriber devices and either the wireless network interface card 230

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141 *KSR*, 127 S. Ct. at page 1742, warning against a "temptation to read into the prior art the teachings of the invention at issue" and instructing ... to "guard against slipping into the use of hindsight."
142 See Final Office Action, page 6.

> or the FDDI network interface 231 or the 100Base-X interface 232. At the same time, MPEG or other compressed video needs to be transferred between an audio visual transport card (not shown) or the video processor (not shown) of the subscriber device and either the wireless network interface card 230 or the ATM network interface card 233. Simultaneously, ATM cells may need to be transferred between the ATM network interface card 233 and one of the other interface cards, for example a USB interface (not shown) or an in-home bus transceiver (not shown).[143] *(Emphasis added)*

Thus, *Jones* teaches, and is limited to teaching, that the wireless router forwards information to the wireless device. *Jones* contains no disclosure that the wireless, or any device, amplifies the packets. *Jones* does not teach or contemplate amplifying packets. Accordingly, *Jones* does not teach each and every element as recited and arranged in Claim 45.

Additionally, Claim 46 recites "receiving a wireless transmission at the wireless router transmitted from the first device." Thereafter, the claim recites "detecting that the received wireless transmission is adequately strong to reach a known destination." Further, the claim recites "not amplifying the received wireless transmission." The Examiner collectively rejects Claim 46 with Claim 45. As such, the Examiner cites *Jones*, column 3, line 49 to column 4, line 26, receiving a packet at the wireless router transmitted wirelessly from the first device (web server 140) detecting that the received wireless transmission is adequately strong to reach a known destination and not amplifying the received wireless transmission.[144] However, nothing in the *Jones* reference illustrates a teaching of a device detecting that the received wireless transmission is adequately strong to reach a known destination.

As stated hereinabove, with respect to Claim 45, *Jones* does not teach or suggest amplifying a packet. The cited portions of *Jones* merely relate to routing and forwarding. *Jones* contains no

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143 See *Jones*, col. 3, ln. 49 – col. 4, ln. 26.

disclosure that the wireless router is capable of, or performs, detecting that the received wireless transmission is adequately strong to reach a known destination. Accordingly, *Jones* does not teach each and every element as recited and arranged in Claim 46.

Grouping of Claims

The claims on appeal <u>do not</u> stand or fall together, as may be seen from the arguments set forth below. Each claim or group of claims that has been argued separately under a separate subheading should be considered separately. While the applicant recognizes that a formal statement regarding the grouping of claims is no longer required, each claim should be considered separately; or at the very least each claim which is argued separately in the preceding sections of this brief should be considered separately.

Conclusion

In summary, the single reference to *Lincke* cited by the Examiner fails to anticipate Appellants' inventive concept as defined by the presented claims. Further, the cited reference fails to teach each and every limitation, expressly or inherently because the text fails to illustrate "why" one skilled in the art would see no difference between the instant application and the cited reference. Additionally, the cited references fail to provide a teaching, suggestion or motivation for the combination because the text fails to illustrate "why" one skilled in the art would combine the references in the particular manner required. Instead, the Examiner simply identifies particular components from the *Lincke* reference, construes them in a specific manner required by Appellants' claimed invention, and then states that the cited reference anticipates. Additionally, the Examiner identifies particular components from the *Gershman*, *Jones* and *Dolan* references, combines them in a specific manner required by Appellants' claimed invention, and then states it would be obvious to one skilled in the art to do so. This is clearly conclusory reasoning that contravenes the standards imposed by both the MPEP and the Federal Circuit. Appellants respectfully submit that the cited references are improper for reasons detailed above and requests that the rejections under § 102 and § 103 be withdrawn.
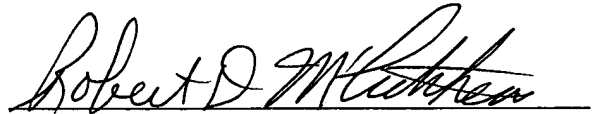
REQUESTED RELIEF

The Board is respectfully requested to reverse the outstanding rejections and return this application to the Examiner for allowance.

Respectfully submitted,

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<u>APPENDIX A -</u>

CLAIMS APPENDIX

Claim 1.   A method of processing a packet in a wireless network, comprising:

receiving a data packet having data therein at a first device capable of wirelessly communicating with a second device;

associating the data with a one of a plurality of network enabled software applications executing on the first device and generating display information in response to processing by the one of the plurality of network enabled software applications for use by the second device in producing a display on the second device; and

the first and second devices performing wireless transmissions to one another through a wireless router, wherein performing wireless transmissions to one another through the wireless router further comprises,

providing a first wireless communication link between the first device and the wireless router in accordance with a first wireless protocol, and

providing a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol.

Claim 2.   The method of Claim 1 wherein the software application executes on a wireless server.

Claim 3.   The method of Claim 1 wherein the software application executes in the

background.

Claim 4.   The method of Claim 1 further comprising using the data to update the software

application.

Claim 5.   The method of Claim 1 further comprising converting the data packet into a data

stream.

Claim 6.   The method of Claim 1 wherein the data is a command that causes the program to

perform a predetermined operation.

Claim 7.   The method of Claim 1 wherein a transmitter comprising the first device receives

the data packet.

Claim 8.   The method of Claim 1 further comprising compressing the data packet.

Claim 9.   The method of Claim 1 further comprising generating a video stream indicative of

a visual display, the visual display associated with the software application.

Claim 10.   The method of Claim 9 further comprising compressing the video stream.

Claim 11.   The method of Claim 9 further comprising organizing the video stream into at least one video packet.

Claim 12.   The method of Claim 11 further comprising transferring the video packet from a wireless server to a wireless transmitter.

Claim 13.   The method of Claim 11 further comprising transmitting the video packet.

Claim 14.   The method of Claim 13 further comprising transmitting the video packet via a wireless protocol.

Claim 15.   The method of Claim 14 wherein the wireless protocol is a Bluetooth protocol.

Claim 16.   The method of Claim 14 wherein the wireless protocol is the IEEE 802.11 protocol.

Claim 17.   The method of Claim 14 wherein the wireless protocol is a Home RF protocol.

Claim 18.   The method of Claim 13 further comprising transmitting the packet via a plurality of wireless protocols.

Claim 19.   The method of Claim 2 wherein the wireless server simultaneously executes multiple instances of the software application.

Claim 20.   The method of Claim 1 further comprising transmitting an audio stream associated with the application.

Claim 21.   The method of Claim 1 further comprising converting an audio stream into at least one audio packet.

Claim 22.   The method of Claim 21 further comprising transmitting the at least one audio packet.

Claim 30.   The method of Claim 22 further comprising displaying a registration page.

Claim 32.   The method of Claim 30 further comprising sending a video packet via wireless protocol.

Claim 33.   A method of processing a packet in a wireless network, comprising:

wirelessly receiving a data packet having data therein at a first device capable of wirelessly communicating with a second device;

employing the data in producing a display on the first device for a one of a plurality of network enabled software applications executing on the second device and generating display

information in response to processing by the one of the plurality of network enabled software applications for use by the first device; and

the first and second devices performing wireless transmissions to one another through a wireless router, wherein performing wireless transmissions to one another through the wireless router further comprises,

providing a first wireless communication link between the first device and the wireless router in accordance with a first wireless protocol, and

providing a second wireless communication link between the wireless router and the second device in accordance with a second wireless protocol.

Claim 36.   A computer system in a wireless network, the computer system for processing a packet in a wireless network, the computer system comprising:

a first device; and

a second device capable of wirelessly communicating with the first device and wirelessly receiving a data packet having data therein from the first device, the second device employing the data to generate a display on the second device associated with a one of a plurality of network enabled software applications executing on the first device;

wherein the first and second devices perform wireless transmissions to one another through a wireless router, and wherein a first wireless communication link is provided between the first device and the wireless router in accordance with a first wireless protocol and a second wireless communication link is provided between the wireless router and the second device in accordance with a second wireless protocol.

Claim 37.   A computer-readable medium whose contents cause the processing of a packet in

a wireless network by:

receiving a data packet having data therein at a first device capable of wirelessly

communicating with a second device; and

associating the data with a one of a plurality of network enabled software applications

executing on the first device and generating display information in response to processing by the

one of the plurality of network enabled software applications for use by the second device in

producing a display on the second device;

wherein the first and second devices perform wireless transmissions to one another

through a wireless router, and wherein a first wireless communication link is provided between

the first device and the wireless router in accordance with a first wireless protocol and a second

wireless communication link is provided between the wireless router and the second device in

accordance with a second wireless protocol.

Claim 40.   In a wireless network, a computer-readable medium whose content transforms a

computer system into a packet processing system, comprising:

a wireless packet receiving subsystem that receives, via wireless transmission from an

external device, a data packet having data therein; and

a data association subsystem that associates the data with a one of a plurality of network

enabled software applications which is executing on the packet processing system and which

generates, for wireless transmission to the external device, display information in response to

processing by the one of the plurality of network enabled software applications for use by the external device to produce a display on the external device, wherein the packet processing system and the external device perform wireless transmissions to one another through a wireless router, and wherein a first wireless communication link is provided between the first device and the wireless router in accordance with a first wireless protocol and a second wireless communication link is provided between the wireless router and the second device in accordance with a second wireless protocol.

Claim 45.   The method of Claim 1 further comprising:

receiving a packet at the wireless router transmitted wirelessly from the first device;

amplifying the packet;

transmitting wirelessly the amplified packet to the second device.

Claim 46.   The method of Claim 1 further comprising:

receiving a wireless transmission at the wireless router transmitted from the first device;

detecting that the received wireless transmission is adequately strong to reach a known destination; and

not amplifying the received wireless transmission.

APPENDIX B -
Evidence Appendix

Not Applicable – No other evidence was entered.

APPENDIX C -
Related Proceedings Appendix

Not Applicable -- To the best knowledge and belief of the undersigned attorney, there are none.